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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,767	08/28/2003	Masaki Takai	241959US0	5868

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EXAMINER

KEYS, ROSALYND ANN

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/649,767

Applicant(s)

TAKAI ET AL.

Examiner

Rosalynd Keys

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-16, 18-26 and 30-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-16, 18-26 and 30-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1621

DETAILED ACTION

1. Claims 7-16, 18-26 and 30-32 are pending.

Claims 7-16, 18-26 and 30-32 are rejected.

Claims 1-6, 17 and 27-29 are canceled.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 7-16, 18-26 and 30-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added limitation "is a compound in which X in the first allyl compound is substituted with AO" in reference to the second allyl compound, is not disclosed in the original specification. The AO group is only used in reference to the oxygen nucleophilic agent.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 7-9, 11, 14, 15, 18, 22-24, and 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Trost et al. (US 4,051,157), for the reasons given in the previous office action, mailed March 21, 2006.

Art Unit: 1621

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 7-16, 18-26 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurtz et al. (US 3,755,451) alone or in view of Bryant et al. (US 3,534,088) or Hefner, Jr. (US 4,613,703), for the reasons given in the previous office action mailed March 21, 2006.

Response to Amendment

Objection to claim 15

9. The objection to claim 15 is withdrawn due to the amendment to said claim filed August 21, 2006.

Rejection of claims 7-16, 18-26 and 30-32 under 35 U.S.C. 112, second paragraph

10. The rejection of claims 7-16, 18-26 and 30-32 under 35 U.S.C. 112, second paragraph is withdrawn due to the amendments to claims 7 and 16, filed August 21, 2006.

Rejection of claims 7-9, 14, 16, 18, and 22 under 35 U.S.C. 102(b) as being anticipated by Pachamuthu et al. (Tetrahedron Letters, Volume 39, May 1998, pp. 5339-5442)

11. The rejection of claims 7-9, 14, 16, 18, and 22 under 35 U.S.C. 102(b) as being anticipated by Pachamuthu et al. (Tetrahedron Letters, Volume 39, May 1998, pp. 5339-5442) is withdrawn due to the newly added limitation "is a compound in which X in the first allyl compound is substituted with AO" in reference to the second allyl compound, in claim 7.

Response to Arguments

Rejection of claims 7-16, 18-26 and 30-32 under 35 U.S.C. 112, first paragraph

12. Applicant's arguments, see the first two paragraphs on page 10 of the response, filed August 21, 2006, with respect to the rejection of Claims 7-16, 18-26 and 30-32 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, have been fully considered and are persuasive. The rejection of Claims 7-16, 18-26 and 30-32 has been withdrawn.

Rejection of claims 7-9, 14, 16, 18, and 22 under 35 U.S.C. 102(b) as being anticipated by Pachamuthu et al. (Tetrahedron Letters, Volume 39, May 1998, pp. 5339-5442)

13. Applicant's arguments, see the last paragraph on page 10 of the response, filed August 21, 2006, with respect to the rejection of Claims 7-9, 14, 16, 18, and 22 under 35 U.S.C. 102(b) as being anticipated by Pachamuthu et al. (Tetrahedron Letters, Volume 39, May 1998, pp. 5339-5442) have been fully considered and are persuasive. The rejection of claims 7-9, 14, 16, 18, and 22 has been withdrawn.

Rejection of claims 7-9, 14, 18, 22, 24, 30, 31 and 32 under 35 U.S.C. 102(b) as being anticipated by Woo (US 4,567,005)

14. Applicant's arguments, see page 11 of the response, filed August 21, 2006, with respect to the rejection of Claims 7-9, 14, 18, 22, 24, 30, 31 and 32 under 35 U.S.C. 102(b) as being anticipated by Woo (US 4,567,005), have been fully considered and are persuasive. The rejection of Claims 7-9, 14, 18, 22, 24, 30, 31 and 32 has been withdrawn.

Rejection of claims 7 and 23 under 35 U.S.C. 103(a) as being unpatentable over Woo (US 4,567,005)

15. Applicant's arguments, see page 11 of the response, filed August 21, 2006, with respect to the rejection of Claims 7 and 23 under 35 U.S.C. 103(a) as being unpatentable over Woo (US 4,567,005), have been fully considered and are persuasive. The rejection of claims 7 and 23 has been withdrawn.

Rejection of claims 7-9, 11, 14, 15, 18, 22-24, and 30-32 under 35 U.S.C. 102(b) as being anticipated by Trost et al. (US 4,051,157)

16. Applicant's arguments filed August 21, 2006 have been fully considered but they are not persuasive.

Art Unit: 1621

The Applicants argue that Trost does not anticipate the instant invention because it directed to a process involving carbon nucleophiles. This argument is not persuasive because Trost also teaches the use of oxygen nucleophiles in addition to carbon nucleophiles (see column 4, line 50 to column 5, line 30).

The Applicants argument with regard to superior reactivity with oxygen nucleophiles is not persuasive because a showing of unexpected results is effective to rebut a rejection under 35 USC 103 not a rejection under 35 USC 102.

For the above reasons this rejection is maintained.

Rejection of claims 7-10, 16, 18, 22, 24, 25, 30-32 under 35 U.S.C. 103(a) as being unpatentable over Arend et al. (US 4,017,564).

17. Applicant's arguments, see last paragraph on page 12 of Applicants response, filed August 21, 2006, with respect to the rejection of Claims 7-10, 16, 18, 22, 24, 25, 30-32 under 35 U.S.C. 103(a) as being unpatentable over Arend et al. (US 4,017,564) have been fully considered and are persuasive. The rejection of Claims 7-10, 16, 18, 22, 24, 25, 30-32 has been withdrawn.

Rejection of claims 7-16, 18-26 and 30-32 under 35 U.S.C. 103(a) as being unpatentable over Kurtz et al. (US 3,755,451) alone or in view of Bryant et al. (US 3,534,088) or Hefner, Jr. (US 4,613,703).

18. Applicant's arguments filed August 21, 2006 have been fully considered but they are not persuasive.

The Applicants argue that Kurtz et al. do not suggest selection of specific phosphites of the formula (1). The Examiner disagrees. Kurtz et al. explicitly names phosphites of the formula (1). See column 8, line 54 to column 9, line 10. The showing in Table 1 and 2 is not sufficient to overcome the rejection because it is not commensurate in scope to the protection sought. The Applicants argue that Bryant also does not provide any suggestion or reasonable expectation of success for the claimed process. The Examiner disagrees. Bryant provides the motivation to utilize an ammonium compound with the claimed catalyst, i.e., higher yields, improved selectivity and catalyst stability. The Applicants argue that Hefner is non-analogous art because it does not disclose the catalyst of formula (1). This argument is not persuasive because just like the instant invention Hefner is directed to allylation

Art Unit: 1621

reactions. Further, Hefner is not being utilized for its teaching of the catalyst of formula (10, but for its teaching of the use of ammonium or phosphonium salts in allylation reaction, which is the subject matter of instant claims 25 and 26.

For the above reasons this rejection is maintained.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalynd Keys whose telephone number is 571-272-0639. The examiner can normally be reached on M-W & F 5:30-8:30 am & 1-5 pm; Th 5:30 am-5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Rosalind Keys
Primary Examiner
Art Unit 1621

November 8, 2006